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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,389	10/31/2005	Hans-Joachim Timpe	89946/JLT(58575-316373)	3583
1333	7590	07/27/2007	EXAMINER	
EASTMAN KODAK COMPANY PATENT LEGAL STAFF 343 STATE STREET ROCHESTER, NY 14650-2201			NOLAN, JASON MICHAEL	
		ART UNIT	PAPER NUMBER	
		1626		
		MAIL DATE	DELIVERY MODE	
		07/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/537,389	TIMPE ET AL.	
	Examiner	Art Unit	
	Jason M. Nolan, Ph.D.	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 October 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 15-20 and 25 is/are rejected.
- 7) Claim(s) 21-24 and 26-28 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 10/03/2005.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Claims 15-28 are pending in the instant application; of which, all are new.

Claims 1-14 are canceled.

Priority

This application is a 371 of PCT/EP03/13727, filed on 12/04/2003. Receipt of 102 57 188.0, filed on 10/06/2002 in Germany, submitted under 35 U.S.C. §§ 119(a)-(d) is acknowledged; which papers have been placed of record in the file. Claim for priority in the ADS and Oath is acknowledged.

Information Disclosure Statement

Applicants' information disclosure statement (IDS), filed on 10/03/2005 has been considered. Please refer to Applicants' copy of the 1449 submitted herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15-20 & 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flanagan *et al.* (*Bioconjugate Chem.* 1997, 8, 751-756).

Determination of the scope and content of the prior art (MPEP § 2141.01)

Shown in Scheme 1 on page 754 of Flanagan *et al.* is a synthetic protocol for the synthesis of the cyanine dyes shown in Figure 1 on page 751. Said protocol describes the reaction of compounds **4** and **5** to afford compound **6**, which is the key intermediate, useful for the synthesis of the cyanine dyes shown in Figure 1. Compound **5** is equivalent to "dye A" in the instant application, used in Examples 1-15 & 20. Therefore,

the method described in the prior art is a two-step sequence for the synthesis of formula (I) in the instant application.

Ascertainment of the difference between the prior art and the claims (MPEP § 2141.02)

The difference between the method described in Flanagan *et al.* and the invention of the instant application is that the prior art is a two-step sequence and the instant application is a one-step protocol. The prior art fully describes how to make the cyanine dyes according to formula (I) using well-understood chemistry.

Finding of *prima facie* obviousness--rational and motivation (MPEP § 2142-2413)

The optimization of a known process is *prima facie* obvious. A person of ordinary skill in the art would thus be motivated to utilize the processes as taught by Flanagan *et al.* in order to provide a more economical process. When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

The instantly claimed invention is a combination of known steps in the prior art and, therefore, as a whole would have been obvious to a person of ordinary skill in the art because the parts of the invention were well understood. Success in the

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combination of the steps would have been anticipated, if not suggested to a person of ordinary skill in the art

Claim Objections

Claims 1 & 25 are objected to because of the following informalities: in the definition of compound C, the term "aromatic and heteroaromatic functionalized compounds Ar-B" should be amended to "aromatic or heteroaromatic functionalized compounds Ar-B". Appropriate correction is required.

Claims 21-24 & 26-28 are objected to as being dependent upon rejected base

Claim 15.

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Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is **Jason.Nolan@uspto.gov**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M^cKane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason M. Nolan, Ph.D.
Examiner
Art Unit 1626

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER



Joseph K. M^cKane
Supervisory Patent Examiner
Art Unit 1626
Date: July 23, 2007